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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,387	03/06/2002	Naoki Midoh	2002-0317A	2875

513 7590 12/27/2006
WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
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1656

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/070,387

Applicant(s)

MIDOH ET AL.

Examiner

David J. Steadman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 13 is/are allowed.
- 6) ☒ Claim(s) 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Status of the Application

- [1] Claims 1, 13, and 15 are pending in the application.
- [2] Applicant's amendment to the claims, filed on 13 October 2006, is acknowledged. This listing of the claims replaces all prior versions and listings of the claims in accordance with 37 CFR 1.121(c).
- [3] Applicant's arguments filed on 13 October 2006 have been fully considered and are deemed to be persuasive to overcome the outstanding rejection under 35 U.S.C. 112, first paragraph, for reasons that follow.
- [4] The text of those sections of Title 35 U.S. Code not included in the instant action can be found in a prior Office action.

Claim Rejections - 35 USC § 112, First Paragraph

- [5] The scope of enablement rejection of claims 13 and 15 under 35 U.S.C. 112, first paragraph, is withdrawn in view of the instant amendment to the claims and upon further consideration.

Claim Rejections - 35 USC § 102

- [6] Claim(s) 15 is rejected under 35 U.S.C. 102(a) as being anticipated by Weckwerth et al. (*J Biol Chem* 275:17909; cited in the IDS filed March 06, 2002). Claim 15 is drawn to (in relevant part) an isolated protein encoded by a nucleotide sequence that has at least 95% homology to SEQ ID NO:1 and encodes a protein with PF1022 synthetase activity.

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The reference of Weckwerth et al. teaches isolation of PFSYN, a polypeptide having PF1022 synthetase enzymatic activity from the fungus *Mycelia sterilia* (see particularly page 17910, right column). This anticipates claim 15 as written.

The following examiner's comments are provided to clarify the record. Although Weckwerth et al. is silent as to the amino acid sequence of PFSYN, the polypeptide of Weckwerth et al. would appear to be identical to SEQ ID NO:2 herein because the polypeptides are both isolated from the same source and have the same enzymatic activity. According to MPEP 2112.I, "[t]he discovery of a previously unappreciated property of a prior art composition...does not render the old composition patentably new to the discoverer'...Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable" (citations omitted).

If applicant traverses the instant rejection on the grounds that the reference of Weckwerth et al. is not available as prior art under 35 U.S.C. 102(a), it is noted that a review of the translated foreign priority documents (translations filed on 21 June 2004 and 3 November 2004) suggests that the limitation of part (c) of claim 15, while apparently supported by the international application, is not supported by the foreign priority documents. In analyzing part (c) of claim 15 to determine its effective filing date, the examiner has relied upon MPEP 706.02.V.(B), which states, "[i]f the application is a continuation-in-part of an earlier U.S. application or international application, any claims in the new application not supported by the specification and claims of the parent application

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have an effective filing date equal to the filing date of the new application. Any claims which are fully supported under 35 U.S.C. 112 by the earlier parent application have the effective filing date of that earlier parent application." As such, the effective filing date of the limitation of part (c) of claim 15 is considered to be the date of filing of the international application, *i.e.*, 7 September 2000.

The reference of Weckwerth et al. indicates that the invention was known by others on 4 April 2000 (see 23 July 2004 Office action at p. 8 for a discussion of determining the earliest public availability date of Weckwerth et al.), and as such, the reference is available as prior art under 35 U.S.C. 102(a).

Conclusion

[7] Status of the claims:

Claims 1, 13, and 15 are pending.

Claims 1 and 13 appear to be in condition for allowance.

Claim 15 is rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Steadman whose telephone number is 571-272-0942. The examiner can normally be reached on Mon to Fri, 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr Bragdon can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David J. Steadman, Ph.D.
Primary Examiner
Art Unit 1656



KATHLEEN M. KERR, PH.D.
SUPERVISORY PATENT EXAMINER